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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/718,660	11/24/2003	Takuya Matsumoto	HOK-9022/CON	1610

23353 7590 07/06/2007
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ART UNIT	**PAPER NUMBER**
3622	
MAIL DATE	**DELIVERY MODE**
07/06/2007	PAPER

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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10718660

Filing Date: 24 November 2003

Appellant(s): Takuya MATSUMOTO et al.

Bryan K. Dutton, Esq., For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 30 January 2007 appealing from the Office action mailed 13 January 2006.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings that will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is essentially correct. (At the second heading at the top of p. 3, "**Claims 22-35**" should be "**Claims 25-35**".)

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

The following is a listing of the evidence (e.g., patents, publications, Official Notice, and admitted prior art) relied upon in the rejection of claims under appeal.

Matsumoto et al., US006763334B1, 13 July 2004

Gerace, US005848396A, 8 December 1998

Domine et al., US005949419A, 7 September 1999.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims. With the exception of correcting a typographical error[1], this is a verbatim copy of the final rejection mailed 13 January 2004.

DETAILED ACTION

Double Patenting

1. The **nonstatutory double patenting** rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Omum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

   A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

   Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

2. Claims 25-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over the claims tabulated below of U.S. Patent No. 6,763,334.

Instant Claim	Claim in US Pat. 6,763,334
25	1
26	2
27	5

[1] At three places in para. 6, "proceeder rate" was originally written "proceeder number". The examiner appreciates appellant's courtesy in overlooking this error.

28	9
29-31	respectively 10-12
32-34	1
35	7&8
36-39	1

Instant independent claim 36 is claim 1 in the '334 patent with the first half of its limitations deleted. It is obvious to delete limitations. Instant claims 25-31 are also derived from the claims in the '334 patent in the table given above by deleting the first half of the limitations of parent claim 1. Independent claim 25 also differs from independent claim 35 by using the obvious phrase "a result number is the number of actions made in response to an action object for necessitating processing at said action process module" in place of the claim 35/claim 1 phrase "a result number is the number of the access to said process module". Claims 26-31 otherwise do not differ materially from the '334 pat. claims indicated in the table above. Claims 32-34 each add back one or two of the deleted claim 1 limitations. Instant claim 35 is claim 8 in the '334 pat. with the file definitions copied from claim 7. Claim 37 is the method equivalent of system claims 25/1. Claims 38 and 39 are taught inherently because the common mouse button reads on the claimed buttons for display and download.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 25-39 are rejected under 35 U.S.C. 103(a) as being obvious over Gerace (US005848396A) in view of Domine et al. (US005949419A).

5. Gerace teaches (independent claims 25, 36 and 37) a system and method for arranging the delivery of ads over a network (col. 3 line 30), the system comprising: a response measurement module (*User Objects **37d**, **37e** and **37f***, col. 6 lines 41 to col. 7 line 22) counting the number of specific responses made at *web server **27*** running program ***31*** (col. 3 lines 57-62), which reads on at a web site of an advertiser through an ad space

(*banners*, col. 8 line 13-15 and Appendix I, esp. col. 23 lines 18-20) of a network medium; an administration module making a statistical report (col. 3 lines 11-19) for analysis of the counted responses and delivering said statistical report through said agent's server to the advertiser (col. 5 lines 34-37), wherein said web site includes an entrance page (*Home Page*, col. 7 lines 39-45) and an action page (*Financial Pages*, etc.) linked from said entrance page/*Home Page* and containing said ad pages/*banners*, which reads on the entrance page/*Home Page* being linked to the ad pages/*banners*, and where a user of said network may proceed to make at least one specific action of defined responses as a consequence of the ad on said network (col. 5 lines 24-34), and an action process module which responds to said specific action for processing the same, wherein said administration module produces said statistical report listing the page location of each ad (col. 19 lines 7-9) and the number of viewers of each ad (col. 5 lines 27-29), which reads on an action access number (number of accesses to said action page), and a result number (the number of actions made in response to an action object, col. 5 lines 25-34), wherein said statistical report includes a graphic comparison of user density versus click through or purchase density (col. 13 lines 27-29), which reads on a completer rate.

6. Gerace does not teach reporting a page access number (the number of accesses to the entrance page) and a proceeder rate (the ratio of action access number to page access number). However, Gerace does teach compiling page access number data (col. 6 lines 46-48), which reads on the website's *traffic data*. Because Domine et al. teaches (col. 3 line 62 to col. 4 line 12) that traffic is important to the success of a web site, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add reporting of page access number/traffic data to the teachings of Gerace. Furthermore, because proceeder rate is a measure of the rate at which web site traffic is converted to ad viewers, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to also add reporting of proceeder rate to the teachings of Gerace.

7. Note on interpretation of claim terms - Unless a term is given a "clear definition" in the specification (MPEP § 2111.01), the examiner is obligated to give claims their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111). An inventor may define specific terms used to describe invention, but must do so "with reasonable clarity,

deliberateness, and precision" (MPEP § 2111.01.III). A "clear definition" must establish the metes and bounds of the terms. A clear definition must unambiguously establish what is and what is not included. A clear definition is indicated by a section labeled definitions, or by the use of phrases such as "by xxx we mean"; "xxx is defined as"; or "xxx includes, ... but does not include ...".

8. The instant application contains no such clear definitions for any terms, including "ad space", "web site of an advertiser", "log file" and "button". The examiner is accordingly obligated to give these terms their broadest reasonable interpretation, in light of the specification, and consistent with the interpretation that those skilled in the art would reach (MPEP § 2111).

9. Gerace also teaches at the citations given above claims 26, 27, 34 and 35 (inherently). Gerace also teaches claims 29 and 30 (col. 19 line 66 to col. 20 line 2) and claims 32 and 33 (where the *Home Page* reads on the invitation page, col. 17 lines 53-57 and col. 11 line 57 to col. 12 line 41). Gerace also teaches claims 38 and 39 inherently because the common mouse button reads on the claimed buttons for display and download.

10. Neither reference teaches (claims 28 and 31) listing performance statistics on a daily basis and ranking referred URLs. Gerace does teach reporting performance data "by time" (col. 19 lines 62-65) and compiling referred URL data (col. 6 lines 48-50). Because the data are available and would be of value to advertiser customer, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add to the teachings of Gerace that performance statistics are listed on a daily basis and referred URLs are ranked.

(10) Response to Argument

Argument against the rejection of claims 25-39 under the judicially created doctrine of obviousness-type double patenting (top of p. 8)

Appellant makes no attempt to traverse the rejection. In lieu, appellant ask the Board to "hold in abeyance the requirement for a Terminal Disclaimer until all other rejections under prior art have been addressed, and that the Examiner reevaluate the requirement for a Terminal Disclaimer at that time."

There is no good basis for this request. The rejection is not dependent on any other rejection, and appellant has given no reason why the examiner should "reevaluate the requirement for a Terminal Disclaimer". The Board should affirm the double patenting rejection.

Argument against the rejection of claims 25-39 under 35 U.S.C. 103(a) as being obvious over Gerace in view of Domine et al.

Appellant argues,

"Thus, Gerace fails to disclose, teach, or suggest a *proceeder rate*, which is the ratio of the action access number to said page access number, and a *completer rate*, which is the ratio of the result number to said page access number." (P. 10, center, emphasis in the original.)

Dealing with the second point first, the rejection (para. 6) acknowledges that Gerace does not teach proceeder rate. On the first point, the examiner has made a *prima facie* case that Gerace does teach completer rate (last lines of para. 5 above). Before addressing this disagreement it is helpful to further explain the two rates, as follows.

Proceeder Rate ≡ Action Access Number/Page Access Number,

≡ No. of accesses to the action page/
No. of accesses to the entrance page,

= Fraction of entrance page accesses converted to
action page accesses.

Completer Rate ≡ Result Number/Page Access Number,

≡ No. of actions made in response to an action object for necessitating processing at said action process module/
No. of accesses to the entrance page,

= Fraction of entrance page accesses converted to actions.

The Completer rate is the fraction of home page hits converted to user actions, such as clicking on an ad link. Gerace teaches a graphic report (a *mapping*) comparing user density versus click-through or purchase density for some certain ad (col. 13 lines 27-29 or col. 34 lines 16-19). This reads on the claim limitation of "a statistical report" that "includes ... a

completer rate". *User density* measures home page hits. Click through or purchase density measures actions. Gerace does not teach details of this *mapping* comparison, but one of ordinary skill in the art would interpret the mapping to be, for example, a pair of bars at each of various map points, where the higher bar in each pair shows home page hits and the lower bar shows actions. The ratio of the two bars at any given location is the completer rate for users at that location. Again, such a graph would read on "a statistical report" that "includes ... a completer rate" (last three lines of claim 25). That the rate is not necessarily shown as a number is irrelevant because it is defined as a ratio and that is "included" (as a *mapping* of *user density ... versus ... click through or purchase density*), which is the claim limitation.

It is instructive at this point to discuss the logic of combining the two references. The primary reference, Gerace, focuses on the ads presented at a web site, but ignores the importance of getting viewers to that web site. The rejection (para. 6) admits that Gerace does not teach the number of web site home page hits (page access number) or its ratio with action page hits (proceeder rate). The rejection notes that Gerace does acquire home page hit data, but never teaches aggregation of this data into the statistic "page access number". Hence to reject the claims there must be added to Gerace some prior art justification for aggregating the data into "page access number" and for taking the ratio of that with action access number to produce "proceeder rate".

That justification comes from teachings in Domine et al. that getting viewers to the web site is important:

> *First, increased traffic at a Web Site is directly related to the Site's ability to charge increased amounts for electronic advertising.* (Domine et al., col. 3 lines 63-65)
>
> *Second, certain Web Sites are currently or will eventually sell products and/or services over the World Wide Web. Increased exposure to potential customers is a primary means for increased sales.* (Domine et al., col. 4 lines 6-9)

This teaching would suggest to one of ordinary skill in the art that the web page access data acquired by Gerace should be aggregated into the page access number and reported with the other aggregates taught by Gerace (col. 5 lines 27-34). Domine et al. provides a solid dollars and cents justification for giving as much emphasis to the web site home page as Gerace gives to the action pages within the web site.

One of ordinary skill in the art would first find it obvious to add proceeder rate to the teachings of Gerace because ratios are often important in decision-making. The appellant's "completer rate" is the common "click-through ratio" or rate, which is taught by Gerace as the comparison of user density with click through or purchase density.

There are a number of other ratios that would be obvious to compute from the taught or obvious aggregates. One such ratio is the proceeder rate, the fraction of web site hits that result in action page hits. It measures how attractive the action page is to site visitors. One of ordinary skill in the art would appreciate that the choice of action page could bear on the effectiveness of advertising. The proceeder rate is computed as the action access number (number of accesses to the action page) taught by Gerace (col. 5 lines 26-29), divided by the page access number, the latter being obvious to calculate by aggregating observations taught be Gerace.

Appellant argues (p. 11, middle), "there is **no express teaching** within Domine of either a *page access number* or a *proceeder rate*. (Emphasis in the original.) That is correct and implied by the rejection. Applicant continues in the next para. by noting that the final rejection makes assertions (in para. 6 above) "without providing any evidentiary support". However, while it is necessary that every limitation be taught or suggested in the prior art, it is not necessary that every limitation be *expressly* taught *by the documents made of record*. Obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found *in the knowledge generally available to one of ordinary skill in the art* as well as in the references themselves. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

In this case, the primary reference (Gerace) does not teach or suggest reporting a page access number (the number of accesses to the home page) and a proceeder rate (which is derived by dividing page access number into a quantity taught by Gerace). Domine et al. provides strong economic justification for aggregating data already being acquired by Gerace into the page access number for the report. In addition, as has been explained above, proceeder number would have been one of several quotients derivable from page access number that are obvious to those of ordinary skill in the art.

Appellant argues (p. 13, first full para.), "This assertion amounts to nothing more than an "obvious-to-try" situation." That is true, but the U.S. Supreme Court has ruled that "obvious to try" is reasonable in some circumstances:

> "The same constricted analysis led the Court of Appeals to conclude, in error, that a patent claim cannot be proved obvious merely by showing that the combination of elements was 'obvious to try.' Id., at 289 (internal quotation marks omitted). **When there is** a design need or **market pressure to solve a problem and there are a finite number of identified, predictable solutions, a person of ordinary skill has good reason to pursue the known options within his or her technical grasp.** If this leads to the anticipated success, it is likely the product not of innovation but of ordinary skill and common sense. In that instance the fact that a combination was obvious to try might show that it was obvious under §103." (*KSR International Co. v. Teleflex Inc. et al.*, 550 U.S. ___ (2007), emphasis added.)

In the instant case, there is market pressure to deliver useful reports to advertisers, and there are a finite number of quotients or rates that are derivable and could be reported from data acquired by Gerace. One of them is the proceeder rate, and another, for example, would be the Result Number divided by the Action Access Number, the fraction of action page hits which result in actions. The choice among the limited number of ratio options is largely arbitrary. It would have been obvious for one of ordinary skill in the art to report any of these ratios to advertiser customers to see which they prefer.

Appellant argues (last full para. on p. 11) that the claim language is "unambiguous", and that the examiner's interpretations of said language are "merely an attempt to reconstruct the expressed claim language." The claim language is hardly unambiguous. The phrases "proceeder rate", "completer rate", "page access number" and "action access number" each appears only twice in the US patent literature (USPAT and US-PGPub databases). Both of those documents are authored by the instant inventors. No one else uses these terms. As noted in the rejection (para. 7 and 8), the examiner is required to give such terms their broadest reasonable interpretation.

Appellant argues (last full para. on p. 12) that Domine et al. fails to teach or suggest an administrative module adapted to make a statistical report that includes a proceeder rate

and a completer rate. Yes, but the rejection says as much. Therein (para. 5) the examiner states that Gerace teaches such a module adapted to make a statistical report that includes a completer rate. The rejection (para. 6) goes on to note that Gerace does not teach a proceeder rate, but that it would have been obvious to one of ordinary skill in the art, at the time of the invention, to add a proceeder rate to the report.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Donald L. Champagne
Primary Examiner
Art Unit 3622

DONALD L. CHAMPAGNE
PRIMARY EXAMINER

19 June 2007

Conferees:

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